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3. (AMENDED) The interface unit according to claim 4, wherein said plural transmission speeds includes at least two speeds.

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6. (AMENDED) The system according to claim 8, wherein said second speed is faster than the first speed.

7. (AMENDED) The system according to claim 8, wherein said plural transmission speeds includes at least two speeds.

REMARKS

By this Amendment, Applicant amends claims 2, 3, 6, and 7 solely to change the dependencies of these claims. No new matter is introduced. Claims 1-14 remain pending in this application.

As an initial matter, Applicant respectfully requests the Examiner to return a completely initialed copy of the PTO Form 1449 filed with an Information Disclosure Statement (IDS) on January 15, 2002. The Examiner initialed a U.S. Patent document listed at the top of the PTO Form 1449 but did not initial two foreign patent documents listed at the middle of the page. The previously filed IDS contained a statement that a search report issued from the United Kingdom Patent Office in a corresponding application was enclosed setting forth the relevance of these documents. Applicant includes additional copies of the IDS and PTO Form 1449 for the Examiner's convenience.

In the Office Action dated February 10, 2003, the Examiner rejected claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over Mano et al. (U.S. Patent No.

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5,319,700) in view of Davis et al. (U.S. Patent No. 5,491,720). Because the Examiner has not presented a *prima facie* case of obviousness, Applicant respectfully traverses the rejection for the following reasons.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must establish each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, and not be based on applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Applicant's claim 1 includes, among other things, "a first transmitter configured to transmit a type query signal to the telephone terminal at a first speed" and "a second transmitter configured to transmit a speed change request to the telephone terminal and change a transmission speed to a second speed if the received type signal indicates that the telephone terminal is capable of transmitting data at the second speed." Mano does not teach or suggest at least these exemplary elements of claim 1.

Instead, Mano discloses a terminal adapter pooling system that uses a terminal adapter to enable communications between an ISDN and a plurality of data terminals (See col. 2, lines 4-9). The system reduces a data load applied to a central control unit at the calling party signal transmission and the called party number signal reception.

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Furthermore, the Examiner admits Mano does not show using a query signal to determine the type of communication speed required for communication and changing the transmission speed based upon the type of communication speed required (Office Action of September 5, 2002, page 2). However, the Examiner alleges Davis makes up for the deficiencies of Mano. Applicant respectfully disagrees.

To the contrary, Davis discloses a method and system for automatically determining a data communication device type and a transmission speed associated with the data communication device type. An incoming communication is detected on a transmission line, which is connected to transmit and receive hardware. A first communication device transmits a sequence of different signals in either a first communication protocol or a second communication protocol via the transmission line. The transmission line is then monitored for a response signal sent from a second data communication device in response to receipt of a particular signal within the sequence of transmitted signals. Using the relationship between the response signal and the sequence of transmitted signals, the system determines a data communication device type and an optimal transmission speed. See col. 2, lines 17-34.

In summary, the system disclosed in Davis uses two communication devices for determining a transmission speed. A first communication device sends a sequence of various signals, which are then evaluated by the second communication device. The second communication device then sends a response signal based on a particular signal within the signals received from the first communication device. The system thus uses the relationship between the response signal and the transmitted sequence of signals to determine a transmission speed of a device.

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In contrast, Applicant's claim 1 recites a combination including, among other things, "a first transmitter configured to transmit a type query signal to the telephone terminal at a first speed" and "a second transmitter configured to transmit a speed change request to the telephone terminal and change a transmission speed to a second speed if the received type signal indicates that the telephone terminal is capable of transmitting data at the second speed." Davis does not disclose or suggest at least these exemplary features of claim 1. Accordingly, any reasonable combination of Mano and Davis fails to teach or suggest at least these exemplary features of claim 1.

The Examiner alleges "it would have been obvious for any one of ordinary skill in the art at the time the invention was made to modify the invention as taught by Mano to automatically determine [the] type of communication speed required for communication between first device and second device as taught by Davis so that the first and second device may operate at an optimal transmission speed without duplicating communication hardware as taught by Davis" (Office Action, page 4). Applicant respectfully submits that this allegation by the Examiner does not provide a motivation to combine Mano with Davis to arrive at the present invention. The Examiner should therefore withdraw the rejection of claim 1 for at least this additional reason.

Furthermore, Applicant respectfully points out to the Examiner it "is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." See In re Wesslau, 147 U.S.P.Q. 391 (C.C.P.A. 1965). See also M.P.E.P. § 2141.02, p. 2100-120. By contrast, the required motivation to combine references

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must "be found in the prior art, and not based on applicant's disclosure." See M.P.E.P. § 2143 (emphasis added).

In that regard, the present invention, as recited in claim 1, cannot be attained based merely on the combination of Mano and Davis. One skilled in the art would only arrive at the present claimed invention by consulting Applicant's disclosure. In particular, the only way to construct the claimed invention from the cited references would be to rely on aspects related to the present invention. Such reliance, however, would constitute improper hindsight reasoning.

Additionally, there is no suggestion or motivation to modify Mano with Davis to produce Applicant's claimed invention, and such combination would not be appropriate or effective. Even the Examiner's erroneous characterization of Mano and Davis does not establish that there would have been the requisite suggestion or motivation to modify Mano with Davis. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01, p. 2100-124, *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Finally, the Examiner has not demonstrated a reasonable expectation of success for making the proposed combination of Mano and Davis, as required by M.P.E.P. § 2143.02. Accordingly, for at least the above reasons, the Examiner should withdraw the rejection of claim 1.

The Examiner's rejection of independent claims 5, 9-10, 12, and 14 uses the same rationale as the Examiner's rejection of claim 1. Independent claims 5, 9-10, 12, and 14 include recitations of a similar scope as claim 1. For example, independent

claim 5 includes, among other things, "a second transmitter configured to transmit a speed change request to the telephone terminal and change a transmission speed to a second speed if the received type signal indicating that the telephone terminal is capable of transmitting data at the second speed"; independent claim 9 includes, among other things, "causing the interface unit to transmit a speed change request to the telephone terminal and change a transmission speed to a second speed if the received type signal indicates that the telephone terminal is capable of transmitting at the second speed," independent claims 10 and 12 include, among other things, "a detector configured to detect whether or not the telephone terminal is capable of transmitting and receiving data at the second speed"; and independent claim 14 includes, among other things, "a transmitter configured to transmit a type signal to the main unit at a first speed in response to a type query signal transmitted from the main unit at the first speed."

For at least the same reasons as discussed above regarding claim 1, Mano and Davis, taken alone or in combination, fail to teach or suggest at least these exemplary features of independent claims 5, 9-10, 12, and 14. Accordingly, the Examiner should withdraw the rejection of independent claims 1, 5, 9-10, 12, and 14 for at least this reason.

Each of dependent claims 2-4, 6-8, 11, and 13 depend from allowable independent claims 1, 5, 9-10, 12, and 14, and are at least allowable based on the rationale given in the discussion above regarding the independent claims. These dependent claims disclose additional features that are neither suggested nor disclosed by Mano nor Davis, either individually, or in any reasonable combination. Thus, for at

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least this reason, the Examiner should withdraw the rejection of claims 2-4, 6-8, 11, and 13.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 9, 2003

By: *Anthony Lombardi* Reg. No. 53,232
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Filing Date: January 12, 2001

APPENDIX TO AMENDMENT OF MAY 9, 2003

VERSION WITH MARKINGS TO SHOW CHANGES MADE

AMENDMENTS TO THE CLAIMS

2. (AMENDED) The interface unit according to claim 4 [1], wherein said second speed is faster than the first speed.

3. (AMENDED) The interface unit according to claim 4 [1], wherein said plural transmission speeds includes at least two speeds.

6. (AMENDED) The system according to claim 8 [5], wherein said second speed is faster than the first speed.

7. (AMENDED) The system according to claim 8 [5], wherein said plural transmission speeds includes at least two speeds.

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4329-2495

RVB/MJP

PLEASE STAMP TO ACKNOWLEDGE RECEIPT OF THE FOLLOWING:

In Re Application of: Norimasa NIIYA

Application No.: 09/758,321

Group Art Unit: 2642

Filed: January 12, 2001

Examiner: Unknown

For: KEY TELEPHONE SYSTEM AND INTERFACE UNIT FOR KEY TELEPHONE

1. Information Disclosure Statement
2. PTO Form 1449 citing and attaching 3 references

Dated: January 15, 2002

Docket No.: 04329.2495-00000

RVB/MJP/teg - Mail Drop 222



(Due Date: ASAP)

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DMS 1/15/02 8

In re Application of:

Group Art Unit: 2642

Examiner: Unknown

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Sir:

Copies of the listed documents, including any copending patent applications, are attached. Applicant respectfully requests that the Examiner consider the listed documents and indicate that they were considered by making appropriate notations on the attached form.

-1-

In lieu of a statement of relevance or translation of the non-English document, an English language abstract and a search report from the United Kingdom Patent Office in a corresponding application citing the document and setting forth the relevance thereof are enclosed.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that each or all of the listed documents are material or constitute "prior art." If the Examiner applies any of the documents as prior art against any claim in the application and Applicant determines that the cited documents do not constitute "prior art" under United States law, Applicant reserves the right to present to the office the relevant facts and law regarding the appropriate status of such documents.

Applicant further reserves the right to take appropriate action to establish the patentability of the disclosed invention over the listed documents, should one or more of the documents be applied against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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Dated: January 15, 2002

By: Michael J. Pender
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INFORMATION DISCLOSURE CITATION

Atty. Docket No. 4329.2495-00	Serial No. 09/758,321
Applicant Norimasa NIIYA	
Filing Date January 12, 2001	Group: 2642

U.S. PATENT DOCUMENTS

Examiner Initial*	Document Number	Issue Date	Name	Class	Sub Class	Filing Date If Appropriate
BWT	5,193,089	3/9/1993	Tsuchida			

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FOREIGN PATENT DOCUMENTS

	Document Number	Publication Date	Country	Class	Sub Class	Translation Yes or No
BWT	WO 94/28664	12/8/1994	PCT			
BWT	JP 2001028771	1/30/2001	JP			Abstract

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

Examiner

Barry W. Fe

Date Considered

7/18/03

*Examiner:

Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Form PTO 1449

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